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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,390	10/23/2001	Timothy J. Wilkinson	40.0010 C1	7729

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SCHLUMBERGER AUSTIN TECHNOLOGY CENTER  
ATTN: PEHR B. JANSSON, INTELLECTUAL PROP LAW DEPT.  
8311 NORTH FM 620  
AUSTIN, TX 78726

EXAMINER

CHAVIS, JOHN Q

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,390

Applicant(s)

WILKINSON ET AL.

Examiner

John Q. Chavis

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001 and 13 August 2002 and 0.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 106-149 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 106-149 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 October 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 145-188 been renumbered 106-149.

2. The examiner has approved the proposed drawing changes, submitted with the preliminary amendment on 10-23-01.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 108-110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 108 depends on itself; while claims should depend on a preceding claim. Claims 109-110 inherit the defects of claim 108; therefore, it is not clear what is intended. Also, no clear antecedent basis is provided for a "terminal" or a "communicator".

### *Double Patenting*

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

Art Unit: 2124

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 106-149 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-87 of U.S. Patent No. 6,308,317. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, claim 106 is merely a more generic version of claim 58 of '317, claim 112 is merely a generic version of claim 65 ('317) and claim 147 is a generic version of claim 1 ('317).

### 35 U.S.C. 102 REJECTION

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 106-118, 120-128, 130-143, 145, 147 and 149 are rejected under 35 U.S.C. 102(e) as being anticipated by Peyret et al. (5,923,884). The applicant claims a microcontroller with a memory for storing information for communicating with a terminal. The features of the applicant's claim are now presented in a side by side manner with the teachings of Peyret.

What is claimed is:

Peyret

106. A microcontroller for use with a terminal, comprising:

see the title and the abstract of the invention and col. 1 lines 53-56.

a memory storing: a derivative application derived from an application having a class file format by first compiling the application having a class file format into a compiled form and then converting the compiled form into a converted form, and

see fig. 1 and again see the abstract, which indicates that the system uses applets (Java language-derived from a high level language).

Also, see col. 1 lines 4-16 and lines 59-67 and col. 5 lines 59-67.

And an interpreter...; and

See fig. 2, item 42.

a processor coupled to the memory,

see fig. 1, item 22.

the processor configured to use the interpreter to interpret the derivative application for execution.

see fig. 2, item 42 and col. 5 lines 36-67.

The applicant indicates that Peyret does not teach the use of Java or any other high level language; however, the features taught by Peyret reads directly on the Java programming language.

For example, Peyret indicates that "the applets run through the interpreter so that the applets do not have any direct access to the hardware of the smart card", col. 5 lines 44-46; while, the Java programming language (see the newly cited reference Writing Java Applets by John Rodley (Chapter 1), cited only to indicate the inherent features of the Java programming language) indicates that applets are accessed via an interpreter for portability and security purposes. These features are taught by Rodley on pages 9-10 and pages 12-13. Therefore, Peyret's system inherently teaches the use of the Java programming language.

Peyret describes the interpreter as a virtual machine having a piece of software that acts as an interface between the hardware processor and the applets (col. 5 lines 36-51.); while,

Art Unit: 2124

Rodley also indicates that the interpreter is software (different for each CPU and operating system) utilizing the Java Virtual Machine, pages 9-11.

Peyret further indicates that his source code is translated into bytecode, col. 5 lines 59-62; which is also a feature of the Java programming language, see Rodley's page 11.

107. The microcontroller of claim 106, further comprising: a communicator configured to communicate with a terminal. this feature is standard for IC Cards to enable communications between the IC Card and the terminal, see the interface 86 of fig. 4. Note, the IC card contains a microcontroller, see fig. 1 item 22.

108. The microcontroller of claim 108 wherein the terminal has a card reader and the communicator comprises a contact for communicating with the card reader. see col. 7 lines 20-32.

109. The microcontroller of claim 108 wherein the terminal has a wireless communicator and a wireless transceiver for communicating with the wireless communication device. see col. 8 lines 55-61 and col. 9 lines 10-32, which suggests that the smart card can be used to obtain foreign currency (i.e. overseas over a wireless network). See also, col. 7 lines 20-32 (any conventional network... across the world) and col. 8 lines 55-61.

110. The microcontroller of claim 108 wherein the terminal has a wireless communication device and the communicator comprises a wireless transmitter for communicating with the wireless communication device. see the rejection of claim 109 above.

111. The microcontroller of claim 106, wherein the class file format comprises a Java class file format. this feature is inherent via the applets, interpreter, virtual machine and the compilations into bytecode, col. 5 lines 36-67. Also, the security features further indicate that the java class file format is used, col. 5 lines 13-35.

The features taught by Peyret read directly on the Java programming language.

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Art Unit: 2124

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Peyret further indicates that his source code is translated into bytecode, col. 5 lines 59-62; which is also a feature of the Java programming language, see Rodley's page 11.

Claims 112-113 are rejected as claim 106; with the converter being inherent via col. 1 lines 33-52 and col. 5 lines 48-58.

In reference to claim 114, see the rejection of claim 111.

As per claim 115, the features are inherent to enable updates to specific applets that may be associated with other applets, see col. 6 lines 28-65.

Claim 116 is rejected via col. 7 lines 43-67; which provides for authentication via a PIN number.

The features of claim 117 are inherent in banking systems and telephone access systems to check identity before enabling access to the system, col. 8 lines 1-15.

Art Unit: 2124

In reference to claim 118, see the rejections of claims 112-115.

As per claim 120, see col. 3 lines 9-53, which indicates that applications may be removed to enable execution of other applications.

The features of claims 121-123 are inherent Java functions and are therefore rejected via claim 111.

In reference to claims 124-125 and 132, see col. 6 lines 1-27, the cryptographic library provides for access control (permissions) to the system. Also, see col. 5 lines 13-35.

As per claim 126, see the rejection of claim 106.

The features of claims 127-128 are taught via claim 115.

In reference to claims 130-131, see the rejection of claims 118 and 116.

As per claims 133-142, see the rejection of claims 115-117 and 122-125.

The features of claims 143, 145 and 147 are taught via claim 107 in view of col. 1 line 53-col. 2 line

30.

In reference to claim 149, see the rejection of claim 115.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chavis whose telephone number is (703) 305-9665. The examiner can normally be reached on Monday-Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki (**Art Unit 2124**), can be reached on (703) 305-9662. The fax number for this Group is (703) 746-7240 for non-Official faxes.

Official faxes should be sent to (703) 746-7239 and



Application/Control Number: 10/037,390

Page 8

Art Unit: 2124

After Final faxes should be sent to (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



JQC

January 10, 2003



John Chavis  
Patent Examiner